

ADVISORY ACTION

This application is a CIP of PCT/EP03/02439.

Response to Arguments

The amendment filed on March 3, 2008 under 37 CFR 1.116 in reply to the final rejection has been considered and has been entered but is not deemed to place the application in condition for allowance because: the request for consideration does not overcome the rejection of claims 45 and 49 under 35 U.S.C. **102(a)** as being anticipated over Stampfer et al., as discussed below.

Claims 45 and 49 are pending and are under consideration.

Response to Arguments

Applicant's arguments filed March 3, 2008 have been fully considered but they are not persuasive.

Claim Rejection - 35 USC § 102(a) - Maintained

Claims 45 and 49 remain rejected under 35 U.S.C. 102(a) as being anticipated by Stampfer et al.

Claims 45 and 49 are drawn to an alcohol dehydrogenase comprising the amino acid sequence of SEQ ID NO:48.

In response to the previous Office Action, applicants have traversed the above rejection.

Applicants argue that the claims are not anticipated by Stampfer et al. because the instant claims are drawn to an isolated polypeptide having alcohol dehydrogenase and possessing a specific amino acid sequence of SEQ ID NO:48, whereas Stampfer et al. discloses an alcohol dehydrogenase activity of a whole cell lysate, wherein no amino acid sequence associated with the protein is disclosed. Examiner respectfully disagrees. Contrary to applicants' argument, Stampfer et al. does disclose an isolated alcohol dehydrogenase. On page 1014, last paragraph, Stampfer et al. discloses that "[w]e have recently isolated a highly enantioselective secondary-alcohol dehydrogenase^[9] from *Rhodococcus ruber* DSM 44541". On page 1017, under the annotation [9], Stampfer et al. discloses "[e]nzyme purification of fractions containing said enzyme. Regarding applicants' argument that Stampfer et al. does not disclose the amino acid sequence of the enzyme, as discussed previously, the amino acid sequence of an enzyme is an inherent property of the enzyme. Since the alcohol dehydrogenase of Stampfer et al. and the alcohol dehydrogenase of SEQ ID NO:48 of the instant invention are obtained from the same source, as stated by applicants on page 5, 2nd full paragraph on the Remarks, and have the same function, the alcohol dehydrogenase of Stampfer et al. inherently possesses the same material structure and functional characteristics as the alcohol dehydrogenase of claims 45 and 49. Since the Office does not have facilities for examining and comparing applicant's alcohol dehydrogenase with the alcohol dehydrogenase of the prior art, the burden is on the applicant to show a

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novel or unobvious difference between the claimed product and the product of the prior art (i.e., that the alcohol dehydrogenase of the prior art does not possess the same material structure and functional characteristics of the claimed alcohol dehydrogenase). See *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and *In re Fitzgerald et al.*, 205 USPQ 594.

Hence the rejection is **maintained**.

Conclusion

None of the claims are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Pak whose telephone number is 571-272-0935. The examiner can normally be reached 6:30 A.M. to 5:00 P.M. Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nashaat Nashed can be reached on 571-272-0934. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

/Yong D Pak/
Primary Examiner, Art Unit 1652